IN THE UNITED STATES PATENT AND TRADEMARK OFFICE (Attorney Docket No. 06-278)

In the Applic	eation of:)
	John Hillel Moshal) Art Unit: 3714
Serial No.:	10/576,743)) Engagines Lim Hone Sone
Filed:	January 9, 2007) Examiner: Lim, Heng Seng)
Title: Redundant Gaming System) Confirmation No. 8207

Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450

PETITION TO WITHDRAW PREMATURE DESIGNATION OF FINALITY

Dear Sir:

Pursuant to 37 C.F.R. § 1.181, Applicant hereby petitions the Office to withdraw the designation of finality in the Office Action mailed November 24, 2008 as being premature. *See* MPEP §§ 706.07(c) and 1002.02(c). In support, Applicant states as follows:

Background

- 1. On November 15, 2007, an Office Action was mailed that rejected all pending claims (i.e., claims 1-25) in the above-referenced application. The rejections were based on references identified as Sakamoto, Pease, and Crumby.
- 2. On February 8, 2008, Applicant filed a Response that canceled claims 1-25 and added new claims 26-40. The Response also explained how claims 26-40 were patentable over the cited references (Sakamoto, Pease, and Crumby).

MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP 300 SOUTH WACKER DRIVE CHICAGO, ILLINOIS 60606 TELEPHONE (312) 913-0001 3. On April 24, 2008, an Office Action was mailed that rejected the new claims 26-

40 based on the same references (Sakamoto, Pease, and Crumby). The Examiner designated this

Office Action as final, arguing that "Applicant's amendment necessitated the new ground(s) of

rejection presented in this Office Action."

4. On July 16, 2008, Applicant filed a Notice of Appeal with a Pre-Appeal Brief

Request for Review. The Pre-Appeal Brief Request included Applicant's "Reasons for Review

of Final Rejection" that set forth reasons why the Examiner's claim rejections were clearly

erroneous.

5. On September 16, 2008, a Notice of Panel Decision from Pre-Appeal Brief

Review was mailed. The Notice stated: "The rejection is withdrawn and a new Office Action

will be mailed." Thus, the Panel decided to reopen prosecution, confirming that the rejections

set forth in the Office Action mailed April 24, 2008 were clearly erroneous.

6. On November 24, 2008, an Office Action was mailed that again rejected claims

26-40, but based on new grounds. Specifically, the rejections were based on a new set of

references, identified as Coile, Holch, and Duncombe. The Office Action was designated final.

According to the Office Action, the designation of finality was justified by the amendment filed

on 2/28/2008. In fact, however, the new Office Action was necessitated by the Panel's decision,

not by any amendment.

7. The undersigned contacted the Examiner by telephone and explained that the

Office Action mailed November 24, 2008 should not be designated final because it was not

necessitated by amendment. The Examiner refused to withdraw the designation of finality,

arguing that it was justified by MPEP § 1207.04.

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Argument

"Under present practice, second or subsequent actions shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement." See MPEP § 706.07(a). In this case, the Office Action mailed November 24, 2008 contains new grounds of rejections. However, the new grounds of rejections are not necessitated by any amendment of the claims by Applicant or by any information submitted in an information disclosure statement. The 2/28/2008 amendment may have necessitated new grounds of rejection in the Office Action mailed April 24, 2008, but that amendment certainly did not necessitate the new grounds of rejection in the Office Action mailed November 24, 2008. Instead, the Office Action mailed November 24, 2008 was necessitated by the Panel's decision to reopen prosecution. In other words, the new grounds of rejection in the Office Action mailed November 24, 2008 were necessitated by the fact that the grounds of rejection in the previous Office Action were clearly erroneous. Therefore, the Office Action mailed November 24, 2008 should not be designated final.

The Examiner's reliance on MPEP § 1207.04 is unavailing. That section allows an examiner to "reopen prosecution to enter a new ground of rejection after appellant's brief or reply brief has been filed." But Applicant has not filed any appeal brief. Therefore, MPEP § 1207.04 simply does not apply. Moreover, MPEP § 1207.04 states that "[t]he Office action containing a new ground of rejection may be made final if the new ground of rejection was (A) necessitated by amendment, or (B) based on information presented in an information disclosure statement." Again, the new grounds of rejection in the Office Action mailed November 24, 2008 were not necessitated by amendment or by information presented in an information disclosure

MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP 300 SOUTH WACKER DRIVE CHICAGO, ILLINOIS 60606 TELEPHONE (312) 913-0001 statement. Instead, the new grounds of rejection were necessitated by the fact that the previous

grounds of rejection were clearly erroneous, as indicated by the Panel's decision to reopen

prosecution.

Accordingly, the designation of finality in the Office Action mailed November 24, 2008

is premature. Applicant respectfully requests that the premature designation of finality be

withdrawn.

Respectfully submitted,

Date: January 30, 2009

By: Richard A. Machankin

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